

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Customer Number: 46320
Yuhji YAMASHITA, et al. : Confirmation Number: 2216
Application No.: 10/673,812 :
Filed: September 29, 2003 : Group Art Unit: 2109
For: RELAY PROCESSING APPARATUS, CONTROL METHOD AND PROGRAM
THEREFOR, AND TERMINAL CONTROL SERVER :
Examiner: M. Fearer

REQUEST FOR RECONSIDERATION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following Remarks are submitted in response to the Office Action dated May 29,
2007.

REMARKS

At the time of the Office Action dated May 24, 2007, claims 1-9 were pending and rejected in this application.

**CLAIMS 1, 3-4, AND 8-9 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION
BASED UPON VILAGHY ET AL., "E-BUSINESS COOKBOOK FOR z/OS VOLUME 1. TECHNOLOGY
INTRODUCTION" (HEREINAFTER VILAGHY)**

On pages 2-4 of the Office Action, the Examiner asserted that Vilaghy discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.² As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.³ This burden has not been met.

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

³ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

As noted by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,⁴ a clear and complete prosecution file record is important in that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process." The Courts that are in a position to review the rejections set forth by the Examiner (i.e., the Board of Patent Appeals and Interferences, the Federal Circuit, and the Supreme Court) can only review what has been written in the record; and therefore, the Examiner must clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner in the statement of the rejection.

This requirement that the Examiner clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner in the statement of the rejection is found in with 37 C.F.R. § 1.104(c), which reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Moreover, in the unpublished opinion of Ex parte Pryor⁵, the Board of Patent Appeals and Interferences recognized the necessity for an Examiner to supply sufficient information to establish a prima facie case of anticipation. Specifically, the Board wrote:

At the outset, we note the examiner has been of little help in particularly explaining the rejections on appeal. A mere statement that claims stand rejected "as being clearly anticipated by" a particular reference, without any further rationale, such as pointing out corresponding elements

⁴ 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

⁵ Appeal No. 1997-2981.

between the instant claims and the applied reference, fails to clearly make out a prima facie case of anticipation. (emphasis in original)

Despite the very specific requirement for the Examiner to clearly set forth the rationale for the rejection and clearly and particularly point out those elements within the applied prior art being relied upon by the Examiner, the Examiner has failed to do so. Instead, the Examiner's statement of the rejection simply consists of the Examiner repeating, almost word-for-word, each of the recited claims and asserting that entire passages within the claims are disclosed by certain specified passages within Vilaghy. The manner in which the Examiner conveyed the statement of the rejection, however, has not "designated as nearly as practicable" the particular parts in Vilaghy being relied upon in the rejection.

It is practicable for the Examiner, for each of the claimed elements, to specifically identify each feature within Vilaghy being relied upon to teach each of the particular claimed elements. For example, the Examiner can "specifically identify" a feature, corresponding to the claimed element, within the applied prior art by identifying a reference numeral associated with the feature. In addition to or alternatively, the Examiner may cite to a brief passage (i.e., 1 or 2 lines or even a portion of a line) within the applied prior art that identifies the feature that corresponds to the claimed element. However, merely citing a long passage or an entire paragraph to disclose a single (or multiple) claimed elements does not designate "as nearly as practicable," the particular features within Vilaghy being relied upon by the Examiner in the rejection.

The importance of the specificity requirement of 37 C.F.R. § 1.104(c) are also further evident in M.P.E.P. § 706.07, which states:

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

A clear issue, however, cannot be developed between Applicants and the Examiner where the basis for the Examiner's rejection of the claims is ambiguous. The Examiner's "analysis" provides little insight as to (i) how the Examiner is interpreting the elements of the claims and (ii) what specific features within Vilaghy the Examiner believes identically discloses the specific elements (and interactions between elements) recited in the claims. By failing to specifically identify those features within Vilaghy being relied upon in the rejection, the Examiner has essentially forced Appellants to engage in mind reading and/or guessing to determine how the Examiner is interpreting the elements of the claims and what specific features within Vilaghy the Examiner believes identically disclose the claimed invention.

In this regard, Appellants respectfully request that if the Examiner is to continue to rely upon Vilaghy, the Examiner identify each specific feature in Vilaghy being relied upon in the Examiner's analysis to allegedly teach the following claimed limitations: (i) control program, (ii) terminal, (iii) HTTP server program, (iv) terminal request processor, (v) control request processor, (vi) a notification that a first command has been received, (vii) returning the first command to the HTTP server program, (viii) returning the command to the terminal in the HTTP response [claim 1], (ix) shifting the terminal request processor into a halted state while maintaining an execution state after transmitting the function call to the control program, (x) recovering from the halted state and returning processing control and the first command to the HTTP server program [claim 3], (xi) the control request processor transmitting the reception

notification to the terminal request processor, (xii) transmitting the reception notification to the terminal request processor, and (xiii) responsive to a following second function call from the HTTP server program for recovering from the halted state and returning processing control to the control program [claim 4].

Notwithstanding the Examiner's ambiguous rejection, Applicants note that the Examiner relied upon "Web component tier" to teaching the claimed terminal request processor (see top of page 3 of the Office Action). However, Vilaghy teaches that the Web component tier gets the client requests. On the contrary, the claimed invention recites that the HTTP server program initially receives the HTTP request for the terminal. Thus, based upon this limitation alone, Vilaghy fails to identically disclose the claimed invention, as recited in claim 1, within the meaning of 35 U.S.C. § 102.

With regard to the claimed "control request processor," the Examiner relied upon the teachings found on page 67 of Vilaghy. Although the Examiner's analysis is completely unclear in this regard, Applicants presume that the Examiner is relying upon "WebSphere" to teach the claimed "control request processor." The control request processor, as claimed, transmits a notification to the terminal request processor, which the Examiner previously asserted was identically disclosed by "Web component tier." However, page 67 is completely silent as to the Web component tier. Thus, Vilaghy further fails to identically disclose the claimed invention, as recited in claim 1, within the meaning of 35 U.S.C. § 102.

Therefore, for the reasons stated above, Applicants respectfully submit that the Examiner has failed to establish that Vilaghy identically discloses the claimed invention, as recited in claims 1, 3-4, and 8-9, within the meaning of 35 U.S.C. § 102.

**CLAIM 2 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON VILAGHY
IN VIEW OF HOFFMAN, U.S. PATENT NO. 6,728,769**

On pages 5-6 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been motivated to modify Vilaghy in view of Hoffman to arrive at the invention corresponding to that claimed. This rejection is respectfully traversed.

Claim 2 depends ultimately from independent claim 1, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for anticipation based upon Vilaghy. The Examiner's secondary reference to Hoffman does not cure the argued deficiencies of Vilaghy. Thus, even if the applied prior art were combined in the manner suggested by the Examiner, the claimed invention would not result. Applicants, therefore, respectfully submit that the imposed rejection of claim 2 under 35 U.S.C. § 103 for obviousness based upon Vilaghy in view of Hoffman is not viable and, hence, solicit withdrawal thereof.

**CLAIM 5 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON VILAGHY
IN VIEW OF DEVINE ET AL., U.S. PATENT NO. 6,598,167 (HERIENAFTER DEVINE)**

On page 7 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been motivated to modify Vilaghy in view of Devine to arrive at the invention corresponding to that claimed. This rejection is respectfully traversed.

Claim 5 depends ultimately from independent claim 1, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for anticipation based upon Vilaghy. The Examiner's secondary reference to Devine does not cure the argued deficiencies of Vilaghy. Thus, even if the applied prior art were combined in the manner suggested by the Examiner, the claimed invention would not result. Applicants, therefore, respectfully submit that the imposed rejection of claim 5 under 35 U.S.C. § 103 for obviousness based upon Vilaghy in view of Devine is not viable and, hence, solicit withdrawal thereof.

**CLAIM 6 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON VILAGHY
IN VIEW OF PERLMAN ET AL., U.S. PATENT NO. 6,510,523 (HERIEN AFTER PERLMAN)**

On pages 8 and 9 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been motivated to modify Vilaghy in view of Perlman to arrive at the invention corresponding to that claimed. This rejection is respectfully traversed.

Claim 6 depends ultimately from independent claim 1, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for anticipation based upon Vilaghy. The Examiner's secondary reference to Perlman does not cure the argued deficiencies of Vilaghy. Thus, even if the applied prior art were combined in the manner suggested by the Examiner, the claimed invention would not result. Applicants, therefore, respectfully submit that the imposed rejection of claim 6 under 35 U.S.C. § 103 for obviousness based upon Vilaghy in view of Perlman is not viable and, hence, solicit withdrawal thereof.

**CLAIM 7 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON VILAGHY
IN VIEW OF KANEMAKI ET AL., U.S. PATENT PUBLICATION NO. 2002/0138761 (HERIENAFTER
KANEMAKI)**

On pages 9-11 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been motivated to modify Vilaghy in view of Kanemaki to arrive at the invention corresponding to that claimed. This rejection is respectfully traversed.

Claim 7 depends ultimately from independent claim 1, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for anticipation based upon Vilaghy. The Examiner's secondary reference to Kanemaki does not cure the argued deficiencies of Vilaghy. Thus, even if the applied prior art were combined in the manner suggested by the Examiner, the claimed invention would not result. Applicants, therefore, respectfully submit that the imposed rejection of claim 7 under 35 U.S.C. § 103 for obviousness based upon Vilaghy in view of Kanemaki is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: August 29, 2007

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320